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Application No.: 10/037,236

Conf. N.: 6669

Art Unit: 3732

A3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application

Inventor(s): James F. Zucherman et al.

SC/Serial No.:

Confirm. No.:

Filed: November 9, 2001

Title: INTER-SPINOUS PROCESS IMPLANT AND
METHOD WITH DEFORMABLE SPACER

PATENT APPLICATION

Art Unit:

Examiner:

Customer No. 23910

DECLARATION FOR C-I-P PATENT APPLICATION

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name;

I believe I am the original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention of the **present application**:

Title of invention and of **present application**:

INTER-SPINOUS PROCESS IMPLANT AND METHOD WITH DEFORMABLE SPACER

The specification of the **present application** (check applicable ones):

✓ is filed herewith;

✓ was filed with the above-identified "Filed" date and "SC/Serial No."

 was amended on (or amended through) .

I have reviewed and understand the contents of the above-identified specification for the **present application**, including the claims, as amended by any amendment(s) referred to above.

I acknowledge the duty to disclose information which is material to the examination of the **present application** in accordance with Title 37, Code of Federal Regulations, §1.56.

This **present application** in part discloses and claims subject matter disclosed in, and I hereby claim the benefit under Title 35, United States Code §120 of any United States **prior application(s)** listed below:

(1) <u>09/799,215</u> (SC/Serial No.)	<u>March 5, 2001</u> (Filing Date)	<u>Pending</u> (Status-pending, patented, abandoned)
(2) <u>09/473,173</u> (SC/Serial No.)	<u>December 28, 1999</u> (Filing Date)	<u>Patented - Now U.S. Pat.No. 6,235,030</u> (Status-pending, patented, abandoned)
(3) <u>09/179,570</u> (SC/Serial No.)	<u>October 27, 1998</u> (Filing Date)	<u>Patented - Now U.S. Pat. No. 6,048,342</u> (Status-pending, patented, abandoned)
(4) <u>09/474,037</u> (SC/Serial No.)	<u>December 28, 1999</u> (Filing Date)	<u>Patented - Now U.S. Pat.No. 6,190,387</u> (Status-pending, patented, abandoned)
(5) <u>09/175,645</u> (SC/Serial No.)	<u>October 20, 1998</u> (Filing Date)	<u>Patented - Now U.S. Pat. No.6,068,630</u> (Status-pending, patented, abandoned)

This **present application** in part discloses and claims subject matter disclosed in, and I hereby claim priority benefits under 35 U.S.C. §119(e) of any United States provisional application(s):

(1) <u>60/323,467</u> (SC/Serial No.)	<u>September 18, 2001</u> (Filing Date)	<u>Pending</u> (Status-pending, patented, abandoned)
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Insofar as the subject matter of each of the claims of the **present application** is not disclosed in the United States **prior application(s)** in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations §1.56 which occurred between the filing date(s) of the **prior application(s)** and the national or PCT international filing date of this **present application**.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the **present application** or any patent issuing thereon.

(1) Full name of first inventor: James F. Zucherman

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(1) Citizenship: United States

(1) Inventor's signature: 

(1) Date: 11/29/01

(2) Full name of second joint inventor: Ken Y. Hsu

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(2) Citizenship: United States

(2) Inventor's signature: 

(2) Date: 11/29/2001

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(3) Citizenship: United States

(3) Inventor's signature: Charles J. Winslow

(3) Date: 11/29/01

(4) Full name of fourth joint inventor: John Flynn

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(4) Citizenship: United States

(4) Inventor's signature: John J. Flynn

(4) Date: 11/29/01

Title 35, United States Code §120

SECTION 120. BENEFIT OF EARLIER FILING DATE IN THE UNITED STATES

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

Title 35, United States Code, §112 (first paragraph)

SECTION 112. SPECIFICATION

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Title 37, Code of Federal Regulations, §1.56

SECTION 1.56. DUTY TO DISCLOSE INFORMATION MATERIAL TO PATENTABILITY

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§1.97(b)-(d) and 1.98.* However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) prior art cited in search reports of a foreign patent office in a counterpart application, and
- (2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

- (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
- (2) It refutes, or is inconsistent with, a position the applicant takes in:
 - (i) Opposing an argument of unpatentability relied on by the Office; or
 - (ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

(c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) Each inventor named in the application;
- (2) Each attorney or agent who prepares or prosecutes the application; and
- (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.

(d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.

* §§1.97(b)-(d) and 1.98 relate to the timing and manner in which information is to be submitted to the Office.